

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 76/212813

**APPLICANT:** INJECTIMED, INC.

**CORRESPONDENT ADDRESS:**

MATTHEW A NEWBOLES  
STETINA BRUNDA GARRED & BRUCKER  
75 ENTERPRISE STE 250  
ALISO VIEJO CA 92656-2626

MAR 10 2003

**RETURN ADDRESS:**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513  
**ecom105@uspto.gov**

**MARK:** NO EXPOSURE TIME

**CORRESPONDENT'S REFERENCE/DOCKET NO:** INJEC-026T

**CORRESPONDENT EMAIL ADDRESS:**

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	Injectimed, Inc.	BEFORE THE
Trademark:	NO EXPOSURE TIME	TRADEMARK TRIAL
Serial No:	76/212813	AND
Attorney:	Matthew A. Newboles	APPEAL BOARD
Address:	Stetina Brunda Garred & Brucker 75 Enterprise, Ste. 250 Aliso Viejo, CA 92656	ON APPEAL

**EXAMINING ATTORNEY'S APPEAL BRIEF**

Applicant has appealed the Trademark Examining Attorney's final refusal to register the proposed trademark "NO EXPOSURE TIME" for "shielded medical needles; safety

device for hypodermic needles" on the grounds that the mark is merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052 (e)(1).

### I. FACTS

Applicant applied for registration on the Principal Register of the trademark "NO EXPOSURE TIME" for "shielded medical needles; safety device for hypodermic needles" on February 20, 2001. Registration was finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052 (e)(1), because the mark was merely descriptive of the goods. This appeal, which was received on December 30, 2002, follows the Examining Attorney's final refusal on this issue dated April 26, 2002.

### II. ARGUMENT

**THE APPLICANT'S PROPOSED TRADEMARK, "NO EXPOSURE TIME" FOR "SHIELDED MEDICAL NEEDLES; SAFETY DEVICE FOR HYPODERMIC NEEDLES," IS MERELY DESCRIPTIVE WITHIN THE MEANING OF SECTION 2(e)(1) OF THE TRADEMARK ACT, 15 U.S.C. SECTION 1052 (e)(1).**

As described at length in *No Nonsense Fashion, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985), the Trademark Trial and Appeal Board has adopted three different methods for determining whether a mark is descriptive or suggestive. These are whether use of the mark:

- (i) conveys to consumers an immediate idea of the ingredients, qualities or characteristics of the [goods]; or
- (ii) has been so frequent that consumers are unlikely to perceive the term when used in the manner of a trademark as indicating source or origin; or
- (iii) deprives competitors of an apt description of their goods. *Id.* at 507.

Satisfying any one of these tests is adequate for establishing descriptiveness. In this case, based on the first of the criteria set forth in *No Nonsense Fashion*, the applicant's mark is merely descriptive of the applicant's goods.

**A. "NO EXPOSURE TIME" CONVEYS AN IMMEDIATE IDEA OF THE GOODS**

The applicant's proposed mark, NO EXPOSURE TIME, is for use in conjunction with "shielded medical needles; safety device for hypodermic needles." As evidenced by the articles submitted with the Office Action of June 19, 2001 and the Final Office Action of April 26, 2002, the health care industry is concerned about minimizing needle "exposure time" in order to reduce the risk of injury to healthcare workers. These articles also evidence that the industry employs the use of shielded needles and shielded needle devices in order to reduce this risk of exposure.

The applicant's proposed mark describes a characteristic that would be very desirable to health care workers. The wording "NO EXPOSURE TIME," when used in conjunction with shielded needles and needle safety devices, describes needles that are free of risks often associated with the use of needles, such as accidental needle-stick injuries, because the user is not exposed to the tips of these shielded needles. Since there is "no exposure time" associated with the use of the applicant's needles, the users of these needles, healthcare workers in particular, avoid many dangers commonly associated with medical needles. The term "NO" is merely used to modify the term "EXPOSURE TIME" to indicate that the goods do not have, cause or result in any "exposure time" to the user.

The applicant argues that the determination that the mark is merely descriptive is based on a "compounding analytical deducement." Whether or not a particular term is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration

is sought, the context in which the designation is being used, and the significance the designation is likely to have to the average purchaser as he or she encounters the goods or services bearing the designation, because of the manner in which it is used. See, *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

In this case, the applicant intends to use the mark NO EXPOSURE TIME in conjunction with shielded medical needles. The average purchaser or user of such goods would be medical professionals such as nurses and other healthcare providers. The *Lexis/Nexis* articles attached to the Office Actions evidence that the health care industry is concerned about workers' exposure to needles and is in particular interested in reducing needle "exposure time." For example, the January 1, 1999 article from *Nursing Management* speaks of a device called "SafetyGlide" which enables users to shield the needle tip immediately after an injection thus limiting the needle tip "exposure time" to 1.6 seconds. The October 1996 article from *Health Facilities Management* addresses the need for devices to eliminate needlesticks and states that "[m]any health care professionals describe this priority as the need to minimize exposure time to the contaminated sharp needle."

It takes no mental gymnastics to ascertain that the applicant's proposed mark merely describes needles featuring "no exposure time." Consumers familiar with medical needles and the safety issues surrounding the use of these needles will immediately understand that "no exposure time" is a very desirable characteristic of the applicant's needles.

The applicant argues that the Office has failed to meet the burden of establishing a *prima facie* showing of mere descriptiveness because only three excerpts of articles retrieved from the computerized database reference the exact wording of applicant's proposed mark. However, the evidence presented does establish that "exposure" to needles is a hazard to healthcare workers and the healthcare industry is concerned about reducing needle "exposure time." The fact that the

applicant may be the first and only user of the term NO EXPOSURE TIME does not justify registration if the term is merely descriptive. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983). A mark which combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001). TMEP §1209.03(d). In this case, the proposed mark is not registrable on the Principal Register because there is no difference in connotation for the composite term NO EXPOSURE TIME from the combination of the common meanings of “no,” “exposure” and “time” as individual words. The term NO EXPOSURE TIME when used on shielded needles immediately tells the relevant consumers that they will be subject to “no” “exposure time” when they use the applicant’s needles.

**B. CONSUMERS ASSOCIATE “EXPOSURE TIME” WITH THE USE OF NEEDLES**

The relevant consumers in this case, such as the healthcare workers who routinely use medical needles, are familiar with the fact that they are at particular risk for injury during the time the sharp needle is exposed. Common experience and the excerpts of articles from the *Lexis/Nexis* database attached to the Office Actions evidence this fact. These articles also evidence the fact that shielded needles are used to reduce or eliminate needle-stick injuries by reducing the time the needle point is exposed. The relevant consumers being thus informed that shielded needles reduce “exposure time” will recognize that the applicant’s proposed mark NO EXPOSURE TIME merely describes a shielded needle that not only reduces, but also eliminates, the exposure time routinely associated with the use of medical needles.

**C. THE MARK IMMEDIATELY DESCRIBES A DESIRED CHARACTERISTIC**

The Board has traditionally viewed descriptiveness in the context of the goods and not in a vacuum. The determination of whether or not a mark is merely descriptive must be made not in the abstract but, rather, in relation to the goods or services for which registration is sought; the context in which the mark is used, or intended to be used, in connection with those goods or services; and the possible significance which the mark would have, because of that context, to the average purchaser of the goods or services in the market place. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

As stated in *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 10 USPQ2d 1801 (7th Cir. 1989), the hypothetical customer, whose state of mind controls the determination of descriptiveness, is a person who has been informed about the product by the advertising and information currently available in the marketplace. Hence, descriptiveness is not to be tested by the view of the "thoroughly uninformed consumer" who is in a "total and unnatural state of disinformation" about the nature of the product. *Id.* at 1809.

The applicant has apparently designed a shielded needle and safety device for needles that may eliminate the risk of needlestick injury by shielding the sharp tip of the needle such that there is never a time when the needle tip is exposed as to cause injury to healthcare workers. The fact that the applicant's shielded medical needles, unlike unprotected needles, at no time expose the users to accidental stick-type injuries is a desirable characteristic of these needles. The average purchaser and user of the applicant's goods will be well-versed in the functioning of medical needles and shielded medical needles and will easily recognize the fact that the mark describes a desired benefit. In viewing the use of the mark NO EXPOSURE TIME on shielded medical needles, the primary significance to the relevant purchasing public will be that of describing a

feature or characteristic of the goods. Therefore, the mark is merely descriptive of the goods within the meaning of the Trademark Act.

### **III. CONCLUSION**

For the foregoing reasons, the refusal to registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052 (e)(1) should be affirmed.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Verna Beth Ririe", written over a horizontal line.

Verna Beth Ririe  
Trademark Attorney

Thomas G. Howell  
Managing Attorney

Law Office 105  
(703) 308-9105